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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/563,875

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Horst Surburg

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10/08/2008

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EXAMINER

GRESO, AARON J

ART UNIT

PAPER NUMBER

4131

MAIL DATE

DELIVERY MODE

10/08/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/563,875	Applicant(s) SURBURG ET AL.	
	Examiner AARON GRESO	Art Unit 4131	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>09 JAN 2006</u> . | 6) <input type="checkbox"/> Other: ____. |

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DETAILED ACTION

Claim Rejections - 35 USC §§ 102/103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over *Yeh and Chow (Perfume and Essential Oil Record 49 pp 70-72 1958)*. One of the chemicals named by the Applicants in Claim 1, 4,8-dimethylnonan-2-one, was previously introduced by the teachings of *Yeh and Chow (Structure V p 70)*; the properties of which are inherent even if not specifically disclosed (*MPEP 716.02(f)*) and would provide desired properties in a perfume or other perfumed article of commerce. The application of the mixed chemical, as a composition, to provide a pleasant odor is indicated by the reference (*2nd paragraph Lines 1-4*). Even though the reference also describes the chemical as “a fragrant but not very pleasant colourless oil” (*page 71, 2nd full paragraph*), in accord with *MPEP 2131.05 paragraph 2* “A reference is no less anticipatory if, after disclosing the invention, the references then disparages it.” Therefore, Claims 1-3 are still rejected.

Claims 1-3 are also rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over *Sethi et al. (Indian Perfumer XXII (4) pp 225-228 1978)*. One of the chemicals named by the Applicants in Claims 1-3 (4,8-dimethyl -7-nonen-2-one) was previously introduced by both the teachings of *Sethi et al (Table 1, Structure (b) p 226)* and is described as having a “coconut rosaceous” odor.

It is noted that the reference by *Sethi et al.* discloses that the compound has a coconut odor, whereas Claim 1 expressly states that the compound does not have a coconut “olfactory note”. However, identical compounds must have identical properties.

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Therefore, the compound of the reference is presumed to possess an olfactory note that is identical to that claimed.

Claims 4-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Burrell et al. (US5306707)* in view of *Yeh and Chow (Perfume and Essential Oil Record 49 pp 70-72 1958)* and in view of *Sethi et al. (Indian Perfumer XXII (4) pp 225-228 1978)*. *Burrell et al.* teaches a genus of compounds encompassing the claimed species (*Column 3 Lines 60-66*). *Burrell et al. (Column 6 Examples 1-5)* further teaches employing a chemical in the genus (2 methyl-2-hepten-6-one) in perfume compositions with more than one fragrance.

Burrell et al. (Column 3 Lines 60-66) discloses the use of saturated or unsaturated aliphatic chemicals having the formula of the chemical-type $R_1-(O)_n-(C=O)-R_2$ where n can be 1 or 0 and R_1 and R_2 are saturated or unsaturated aliphatic groups. For the aliphatic elements, R_1 and R_2 together have no more than 14 carbon atoms while R_2 can have up to 5 carbon atoms; there is no requirement that either R_1 or R_2 be linear. When n is 0, when R_2 is a methyl, and when R_1 is represented by a branched heptene chain; with 2 additional methyl groups (in the 4 and 8 positions) with a double bond (in the 7 position); the Applicants' chemical deemed 4,8-dimethyl-7-nonen-2-one is obviously described. When n is 0, when R_2 is a methyl, and when R_1 is represented by a branched heptane chain with 2 additional methyl groups (in the 4 and 8 positions), the Applicants' chemical deemed 4,8-dimethylnonan-2-one is obviously described.

However, *Burrell et al.* does not provide motivation for choosing the specific chemical species indicated in Claims 4-11. The teachings of *Yeh and Chow (2nd*

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paragraph Lines 1-4) enable this motivation to one skilled in the art to use 4,8-dimethylnonan-2-one to provide for the fragrance. The teachings of *Sethi et al.* enable this motivation to one skilled in the art to use 4,8-dimethyl-7-nonen-2-one to provide for the fragrance.

Claim 4 is rejected because *Burrell et al.* disclose an example using the patent's chemical genus for perfume compositions (*Col 6 Examples 1-5: see 2-methyl-2-hepten-6-one*). Examples of compositions using chemicals of the genus indicated above and those listed in either of Claim 5 or Claim 6 (*Col 6 Examples 1-5*) are also taught by *Burrell et al.* [Note: phenylethyl alcohol indicated in Claims 5 and 6 is another term for 2-phenylethanol in the reference]. Therefore, Claims 5 and 6 are rejected. In addition, an example in the reference shows the percentage of a chemical-type listed above being present in the amount of 5 weight percent. (*Col 6 Example 4*) and is within the amount ranges specified in Claim 9. Claim 10 is rejected because the material in Example 4 (*Col 6*) of the reference is also demonstrated in a perfumed shampoo product (*Col 7 Example 6*).

Claim 11 is rejected because a process for producing a perfume composition of Example 4 that involves adding a chemical from the genus indicated by *Burrell et al.* is also taught (*Col 6 Line 24*).

Claim 8 is rejected because *Burrell et al.* (*Abstract and Col 2 Lines 53-57*) teaches that the chemical-types listed above are added to reduce spoilage as well as to enhance olfactory contribution. It would thus be obvious to one skilled in the art that reducing spoilage enables greater freshness.

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Claim 7 is also rejected under the teachings of the references and in consideration of *MPEP 2144.04 II. A.* which reads "Omission of an element and its function is obvious if the function of the element is not desired." Therefore, leaving out a chemical in a composition (as indicated by Claim 7), that is not one of the required ingredients, is prima facie obvious to one of ordinary skill in the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to AARON GRESO whose telephone number is (571)270-7337. The examiner can normally be reached on M-F 0730-1700.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Sample can be reached on (571) 272-1376. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/David R. Sample/
Supervisory Patent Examiner
Art Unit 4131

AJG